



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/699,804

11/04/2003

Koichiro Yamada

5273-89-1

4022

22852

7590

12/06/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

RAO, DEEPAK R

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,804

Applicant(s)

YAMADA ET AL.

Examiner

Deepak Rao

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,8,10,11 and 14-20 ~~is~~/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,8,11 and 17 ~~is~~/are rejected.
- 7) ☒ Claim(s) 10,14-16 and 18-20 ~~is~~/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/258,545.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20051121 & 20060627</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1624

DETAILED ACTION

Claims 1, 4-5, 8, 10-11 and 14-20 are pending in this application.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on September 13, 2000. It is noted, however, that applicant has not filed a certified copy of the foreign application (Japan **2000-277652**) as required by 35 U.S.C. 119(b). Certified copy of Japan 2000-130371 was received in Application No. 10/258,545.

Withdrawn Rejections/Objections:

Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

The following rejections are necessitated by the amendment:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4-5, 8, 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al., WO 00/76980 (published December 21, 2000). The reference teaches substituted pyrimidine compounds useful as pharmaceutical therapeutic agents having protein kinase C inhibition activity, see formula (I) in page 4 and the compounds of the Examples Table 11, pages 45-50, compounds 26-1 to 35-2. The instant claims differ by reciting 'R³ is an amino group which is substituted', which substituents include a lower alkyl group such as a methyl group. Therefore, the instantly claimed compounds differ by having a methyl (CH₃) group attached to the amino-nitrogen of the R³ substituent as compared to the reference, which teaches an unsubstituted amino group (NH₂) in the analogous position. In other words, the instantly claimed compounds differ from the reference compounds by having a -NH-CH₃ group in place of the reference -NH₂, and the structural similarity of compounds differing by a methyl in place of the hydrogen (i.e., H vs. Methyl) is well established. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the reference compounds to prepare the corresponding methyl substituted compound. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such

Art Unit: 1624

structurally analogous compounds are expected to possess similar properties. It has been held that compounds that are structurally homologous to prior art compounds are *prima facie* obvious, absent a showing of unexpected results. *Ex parte Bluestone*, 135 USPQ 199, and *In re Doebel*, 179 USPQ 158 wherein it was affirmed that N-CH₃ is obvious over N-H.

Note: Applicant cannot rely upon the foreign priority papers to overcome the above rejection(s) because a certified copy of the priority document JP 2000-277652 (filed 9/13/00) and translation of the foreign priority papers (JP 2000-130371 and JP 2000-277652) have not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Allowable Subject Matter

Claims 10, 14-16 and 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Receipt is acknowledged of the Information Disclosure Statement filed on June 27, 2006 and a copy is enclosed herewith. Copy of the IDS filed on November 21, 2005 acknowledging US 6,656,935 is also enclosed herewith.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deepak Rao
Primary Examiner
Art Unit 1624

December 3, 2006